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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,342	09/30/2005	Laurent Dumont	'PLAS-026	5204

32954 7590 08/17/2006

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ALEXANDRIA, VA 22314

EXAMINER

ZIMMER, MARC S

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 08/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/518,342

**Applicant(s)**

DUMONT ET AL.

**Examiner**

Marc S. Zimmer

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/17/04</u> . | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, because the scope of what is contemplated as suitable materials for particulate component (D) cannot be ascertained in view of Applicant's improper use of the word "comprising" within the context of the Markush phraseology at lines 11 and 12 of claim 1. Because "comprising" is employed, there is a connotation that powders other than polyamide may be utilized but the identity of these other polymers is not clear. Correction is required.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al., EP 712 956 in view of Budden et al., U.S. Patent # 6,354,620. Sato discloses the addition of a powder material having an average particle size of between 0.5 and 20 microns (page 2, lines 34 and 35) to a rubbery host polymer as a means of reducing the tacky feel inherent in rubber materials (page 1, lines 23-26). Relevant to the present discussion, addition curable silicone polymers are among the host

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elastomers contemplated (see the preparation example) and polyamide powder is one favored permutation of the powder according to page 2, lines 39-40. Sato advocates using preferably 20-50 parts relative to 100 parts of host rubber.

The only component not expressly disclosed by Sato is the silica particles (E) but silica grains having the properties specified by Applicant's claim are nothing more than a reinforcing-type of silica that is ubiquitously added to silicone compositions to enhance their mechanical properties. Indeed, there are numerous patents directed to coating compositions for textiles that comprise curable silicone rubbers and reinforcing silica, Fujiki et al. being but one example. Concerning claim 3, Budden instructs that no more than 3 wt.% of a reinforcing silica should be used where the composition is to be used as a textile coating composition because any amount above 3 wt.% yields undesirable increases in the coefficient of friction (column 7, lines 9-15).

Concerning claim 4, the dynamic viscosity of the compositions described by Sato is not reported. Nevertheless, one of ordinary skill in the art will judiciously select polymer materials having a viscosity that lends to optimized application characteristics when used with conventional coating techniques.

As for claim 9, the identity of the alkenyl groups possessed by the base polymer component of the addition curable silicone rubber mentioned in Sato's Examples is not revealed but the majority of commercially-available alkenyl-functional siloxane polymers are those bearing vinyl groups and vinyl groups are, in any case, an obvious substituent of an addition-cured organopolysiloxane.

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As for claim 11, it is appreciated that Sato only contemplates a much heavier application amount but this teaching is not all-encompassing nor is it meant to discourage other application quantities. The application amount is offered only by way of example and, in fact, Budden advocates coating rates that are consistent with those recited in claim 11.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 4 and 12-14 are provisionally rejected on the ground of nonstatutory double patenting over claims 19, 21-22, 28, 30, and 32 of copending Application No. 11/000,441. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter. The subject matter of these claims is distinguishable only in that present claim 4 discloses amounts associated with each of the stated components whereas claim 19 of '441 does not contemplate any quantities. Nevertheless, the amounts of the silicone components, catalyst, adhesion promoter, and inhibitor recited are consistent with those ubiquitously employed in addition-curable silicone compositions. As for the quantity of the polyamide component, claim 28 expounds on the invention of claim 19 of '441 by limiting the amount of this material to a quantity that coincides with that advocated in present claim 4. Claim 19 of '441 also does not disclose the geometrical constraints placed on the polyamide filler as delineated in present claim 12 but claims 21 and 22 further limit this component in precisely the same fashion. As for the property limitations placed on the powdered silica in present claim 12, these are inherently true of conventional reinforcing fillers, which are contemplated in claim 19 of '441

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

August 15, 2006

  
MARC S. ZIMMER  
PRIMARY EXAMINER